



# UNITED STATES PATENT AND TRADEMARK OFFICE

MW

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,266	06/07/2000	Barry Dworkin	Dworkin.P001	8568

7590 02/19/2004

AARON T. BORROWMAN, ESQ.  
KELLY BAUERSFELD LOWRY & KLELLEY .LLP  
6320 CANOGA AVENUE  
SUITE 1650  
WOODLAND HILLS, CA 91367

EXAMINER

CHAMPAGNE, DONALD

ART UNIT PAPER NUMBER

3622

DATE MAILED: 02/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/589,266

Applicant(s)

DWORKIN, BARRY

Examiner

Donald L. Champagne

Art Unit

3622

MLW

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See the note at "2" above.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

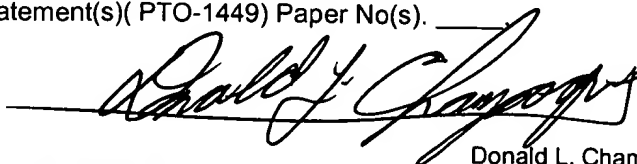
Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 4-13.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_



Donald L. Champagne  
Examiner  
Art Unit: 3622

Continuation of 2. NOTE: Applicant's thoughtful and detailed arguments traversing the "101" rejection would require extensive further consideration. However, the examiner's cursory review suggests that these arguments are not consistent with the Office's present position. The invention as presently claimed comprises, as stated at the beginning of MPEP 2106.IV.B.1(b), "(d)escriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed". The MPEP section goes on to state that such a process "does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 3 USC 101". Amendment of the claims to provide the necessary "functional interrelationship with the way computing processes are performed" is certainly possible by, e.g., providing a computer-readable code, such as the code taught by Rodriguez et al, on the invention card. However, the examiner's cursory review of the specification did not identify such material as being disclosed, so a CIP application might be necessary. And such an amendment would not help distinguish the claims over Rodriguez et al.

The amendments would have to be searched before the examiner could pass judgment. However, it should be noted that Rodriguez et al. does teach paper-based business cards; see the title and para. [0006]. As to the limitation that the code be "visually distinguishable by a cardholder", that is taught by King.

Applicant's arguments traversing the combination of references are also thoughtful and extensive enough to require further consideration. On the surface, they do not appear to be compelling.

Applicant's options for continuing prosecution include a petition to the Supervisory Primary Examiner, Eric Stamber, which can be done by telephone, 703-305-8469, if applicant believes that the examiner has not given the application fair and reasonable consideration. Applicant may continue prosecution on the merits by filing an RCE or CIP, as appropriate. Finally, applicant may appeal to the Board. This last option is the surest way of traversing the rejection under 35 USC 101.

DLL  
2-17-04